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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91210813
Party	Plaintiff SATA GmbH & Co. KG
Correspondence Address	Thomas J. Vande Sande Hall & Vande Sande, LLC 10220 River Road, Suite 200 Potomac, MD 20854 UNITED STATES tv@hvslc.com
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Date	08/14/2014
Attachments	Opposer's Brief in Response to Applicant's Motion to Compel.pdf(313659 bytes) Declaration of Thomas J. Vande Sande, Esquire.pdf(63959 bytes)

Applicant engages in the practice of offering for sale Chinese manufactured paint spray guns under the EURO mark. Realizing that a spray gun manufactured in China lacks desirability amongst potential purchasers of paint spray guns, Applicant chose the EURO designation

attempting to draw upon, and to benefit from, the appeal and accepted correlation between Europe and quality craftsmanship and performance, under the guise of European manufacture. Vendors specializing in the sale of paint spray guns and equipment, including Applicant, extol the virtues and quality of European manufactured guns, including Opposer's European manufactured guns. (See, for instance, Ex. 1 to Vande Sande Dec. attached hereto). Such claims clearly evidence the fact that within the market for paint spray guns there is an established association between Europe and quality craftsmanship. Applicant has even paid Opposer the highest, albeit unwanted, compliment of actually copying Opposer's goods. Applicant is seeking to register the EURO mark while Opposer contends that the mark is misleading as to the geographical origin of the source of the goods.

After months of repeatedly having its reasonable discovery-related inquires go ignored or inadequately answered, and with the discovery deadline set to close on June 26, 2014, Opposer filed a Motion to Compel on June 17, 2014. Applicant subsequently filed its Motion to Compel on June 26, 2014. Opposer filed, on June 27, 2014, a Motion to Strike Applicant's Motion to Compel, noting that Applicant's Motion was untimely, a result of its having been filed subsequent to Opposer's filing and thus contrary to Rule 2.120(e)(2).¹

¹ With respect to Applicant's filing of its Motion to Compel, Opposer agrees that the parties' meet and confer by correspondence efforts proved unsuccessful and that the filing of Applicant's Motion, while barred by Rule 2.120(e)(2), is not barred by Rule 2.120(e)(1). However, Opposer strongly believes, as demonstrated below, that Applicant's Motion is without merit.

Opposer does not agree with Applicant's comments or characterization as such relate to the propriety or timing of Opposer's Motion to Compel. Opposer's related discussion may be found in its Reply Brief in support of its Motion to Compel.

III. THE SPECIFIC DISCOVERY IN DISPUTE

A. Applicant Improperly Seeks Discovery Relating To SATA's Competitors And "Market Share."

The issue in the current proceeding is whether the mark EURO, as applied to paint spray guns manufactured in China, is geographically misdescriptive and thus unregistrable. The relevant discussion in such a determination, as set forth in applicable case law, involves a consideration as to whether (1) the primary significance of the mark is a generally known geographic location, (2) whether the goods or services originate in the place identified in the mark, (3) whether purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark; and (4) whether the involved misrepresentation is a material factor in the consumer's decision to buy the goods or use the services. *In re California Innovations, Inc.*, 66 USPQ2d 1853 (Fed. Cir. 2003). The relevant factors as clearly enunciated by the Board concern only Applicant's mark, yet Applicant has elected to focus much of its discovery on Opposer's market share and Opposer's competitors. By no stretch of the conceivable imagination could information about Opposer's competitors or market share percentages be discoverable or relevant at any stage of this proceeding, when the pertinent inquiry concerns Applicant's EURO mark with respect to the intended and actual impressions created upon potential consumers of paint spray guns and equipment.

1. Applicant's Discovery, Consisting Of Interrogatories 9 And 22, As Well As Document Request 5, Seeking Information From Opposer Regarding Opposer's Competitors, Is Not Relevant Or Discoverable.

Interrogatory 9 seeks information concerning Opposer's competitors and the identification of products manufactured by Opposer's competitors. In a determination of the geographic significance of Applicant's EURO mark in the context of Chinese manufactured paint spray guns, information relating to Opposer's competitors, even if referring to "solely four

products", (App. Mot. To Compel, p. 5) is irrelevant and outside the scope of permissible discovery. Applicant's contention that Opposer's production of a list of its competitors, and products manufactured by its competitors, is somehow germane to the issue of whether the EURO mark is deceptive or misdescriptive is unavailing. Opposer's competitors are not parties to this case and their identity and product listings have no bearing on the significance of Applicant's mark.

Interrogatory 22 seeks studies, tests, or surveys related to the United States market share, performance, and quality of Anest Iwata products sold in the United States. Opposer remains puzzled as to Applicant's continued reference to Anest Iwata products and insistence that such products are relevant to the current proceeding. Anest Iwata is not a party in this case. Applicant is not Anest Iwata, nor does it sell Anest Iwata products. Opposer is not Anest Iwata, nor does it sell Anest Iwata goods. Opposer refuses to believe that information concerning Anest Iwata products is relevant merely because some individuals may attest to the quality of Anest Iwata products. Certainly Applicant is not implying that only one company in the entire paint spray gun industry can enjoy a favorable reputation. Information concerning Anest Iwata is not, and will never be, relevant to this proceeding.

Document Request 5 seeks the production of "All documents relating to your competitors and their competing products for any products that you contend compete with products sold under the name EURO by Mike Ghorbani or M.G. Distributors, Inc." Information concerning the products of competitors remains irrelevant when the matter in dispute concerns the geographic significance of the EURO mark on Applicant's goods which are manufactured in China. Moreover, even if somehow deemed relevant, such a request must be considered overly broad in scope to the point of being unduly burdensome.

2. Applicant's Discovery, Consisting Of Interrogatories 14, 15, 24 And 25 As Well As Document Requests 10 And 11, Seeking Opposer's Market Share And The Market Share Of Opposer's Competitors, Is Not Relevant Or Discoverable.

Interrogatory 14 seeks the market share of Opposer's products in the United States which were previously identified in Interrogatory No. 2. Information concerning Opposer's market share is irrelevant to any issue concerning the registerability of the EURO mark by Applicant and whether the EURO mark possesses geographic significance. In response to Applicant's contention that information concerning Opposer's market share is relevant as a means of proving that potential spray gun purchasers do not prefer European manufactured paint spray guns, Opposer suggests that a manufacturer's market share may be large or small with that fact having no bearing on the reputation of the involved goods. Consider the exact example Opposer previously provided to Applicant concerning the case of Rolls Royce or Bentley automobiles. It would be absurd to call into question the reputation in the automobile industry, or amongst potential purchasers of automobiles, of either Rolls Royce or Bentley despite each company's possession of a negligible market share.

Interrogatory 15 seeks information concerning the market share of any competitors known to Opposer. Despite Applicant's fascination with market share and its claim to the contrary, information concerning the market share of Opposer's competitors in the paint spray gun industry is irrelevant to any issue or foreseeable issue in the current proceeding. Information concerning the market share percentage of Opposer's competitors is far afield from the ultimate issue of the geographic significance of Applicant's mark and thus must be deemed irrelevant.

Interrogatory 24 seeks information concerning the total sales and market share of the four SATA products identified in Interrogatory No. 2. Opposer has adequately addressed this Interrogatory as it relates to total sales inquiries. Opposer maintains the market share

information being requested is irrelevant and undiscoverable, for reasons clearly elaborated above.

Interrogatory 25 seeks information concerning the total sales and market share in Europe of the four SATA models identified in Opposer's Answer to Interrogatory No. 2. There is no conceivable correlation that will ever exist between market share, either in the United States (or much less in Europe), and the principal issue to be decided in this proceeding, that being the geographically misdescriptive nature of Applicant's mark.

Document Request 10 seeks the production of documents relating to Opposer's market share in the United States for SATA products that compete with products sold under the name EURO by Applicant. As noted above, Opposer's market share in the paint spray gun industry is completely irrelevant to this proceeding.

Document Request 11 seeks the production of documents relating to the market share of any of Opposer's competitors for HVLP (high volume low pressure) spray guns in the United States. Opposer regards the request that it produce documentation establishing its competitors' market shares as especially absurd. What possible bearing could such documentation have in regard to a determination of whether Applicant's EURO mark is misdescriptive when applied to Chinese manufactured goods? Opposer cannot imagine what possible relevance documents possessed by it concerning its competitors' market share could have in the current proceeding and thus concludes this information is irrelevant.

B. Applicant's Discovery Requests Regarding Actual Confusion, Consisting Of Interrogatories 13 And 20, As Well As Document Request 9.

Interrogatory 13 seeks information concerning incidents of actual confusion between Opposer's products and products available under the EURO mark. There is no basis from which

Applicant can complain that Opposer's answer is not an accurate, complete, and clear response. Applicant was provided with facts known to Opposer, and has no basis from which to accuse Opposer of providing a vague response.

Interrogatory 20 seeks information regarding each incident known to Opposer of actual confusion where products sold under the EURO mark by Applicant were believed to be from Europe. Applicant has inquired as to incidents known to Opposer, and Opposer has provided Applicant with a complete and unobjectionable response, having provided to Applicant the relevant information in Opposer's possession.

Document Request 9 seeks the production of documentation relating to incidents known to Opposer of actual confusion between Opposer's products and products sold under the EURO mark. Opposer has responded with a complete and unobjectionable answer. Opposer has responded as to what it possesses, and cannot speak as to what other entities may or may not possess in terms of documentation.

C. Miscellaneous Discovery in Dispute Consisting of Interrogatory 19 as well Document Requests 15 and 4.

Opposer assumes Applicant's **Interrogatory 19** refers to "country" rather than "county", in seeking the location of manufacture for various SATA parts. Opposer remains befuddled with Applicant's griping regarding Opposer's Answer, as (1) Opposer has given a complete and detailed response, and (2) the current proceeding revolves not around Opposer's labeling of its goods, but rather Applicant's goods not being manufactured in Europe despite their EURO designation.

Document Request 15 seeks the production of documents relating to the country where various of Opposer's paint spray gun parts are manufactured. Opposer finds it odd that Applicant would request all documents relating to Germany, seeing as how such a request would

yield a limitless production of irrelevant documentation concerning all things German. Despite Applicant's failure to clarify its request, Opposer has repeatedly stated as unambiguously as possible that its paint spray guns are manufactured in Germany and that all component parts are manufactured either in Germany or elsewhere in Europe. Not only does this information not come as a revelation, but it is irrelevant considering that the issue at hand concerns only Applicant's goods, and the deceptive designation of them as EURO when they are manufactured in China.

Document Request 4 can best be understood as seeking documentation concerning Opposer's advertisements for paint spray guns and related equipment. Despite Opposer's Response expressing confusion as to the extent and substance of Applicant's request, Applicant failed to subsequently provide any sort of amendment or explanation. Furthermore, information concerning Opposer's advertising materials is absolutely irrelevant and will never gain relevance in the determination of whether Applicant's use of the EURO mark for its Chinese goods is misdescriptive.

IV. CONCLUSION


Finding Applicant's Motion to Compel to concern matters lacking relevance to the underlying issues of the current proceeding, that being the misdescriptive nature of the EURO mark for goods manufactured in China, or simply relating to matters which Opposer already has provided complete responses thereto, Opposer requests that the Board dismiss Applicant's

Motion pertaining to Interrogatories 9, 13, 14, 15, 19 22, 24, and 25 as well as Document Requests 4, 5, 9, 10, 11, and 15.

Respectfully submitted,

HALL & VANDE SANDE, LLC

Date: 8/14/14



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CERTIFICATE OF SERVICE

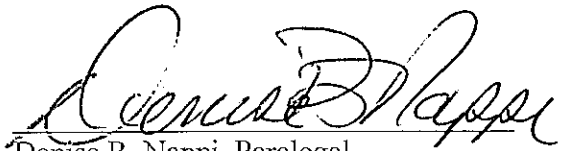
The undersigned, Denise R. Nappi, hereby certifies that one (1) copy of the foregoing "OPPOSER'S BRIEF IN RESPONSE TO APPLICANT'S MOTION TO COMPEL", the attached Declaration of Thomas J. Vande Sande, Esquire and Exhibit 1, thereto, were this day served on Applicant by mailing same, first class mail, to:

Payam Moradian, Esquire
Moradian Law
10880 Wilshire Blvd., Suite 1101
Los Angeles, California 90024

HALL & VANDE SANDE, LLC

Date:

8/14/14

A handwritten signature in cursive script, appearing to read "Denise R. Nappi", written over a horizontal line.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SATA GmbH & Co. KG,

Opposer,

v.

Mike Ghorbani,

Applicant.

Opposition No. 91210813

DECLARATION OF THOMAS J. VANDE SANDE, ESQUIRE

1. The undersigned, Thomas J. Vande Sande, is counsel for Opposer, SATA GmbH & Co. KG, in connection with Trademark Opposition Proceeding No. 91210813, captioned SATA GmbH & Co. KG v. Mike Ghorbani.

2. Attached hereto as Exhibit 1 is a true and accurate copy of a document produced by Applicant in this proceeding and identified by Applicant with production number Ghorbani 000007.

This Declaration is made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001.

Date:

8/14/14

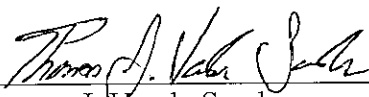

Thomas J. Vande Sande
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Exhibit 1

*1 Affordable Hvlp Spary Guns***AFFORDABLE HVLP SPRAY GUNS**

Painting jobs can be quite tiresome, thus, one needs a reliable spray paint gun to aide one in the task. Moreover, the price should also be affordable, too, to the consumers' budget. Thus, one needs a high volume low-pressure (HVLP) spray paint gun. This is very useful for applying varnishes, lacquers, stains and paints of all kinds. The operating concept of the HVLP spray gun is that it is connected to a turbine motor that pushes a high volume of warm air under low pressure into the spray gun which derives its name. However, there are also other HVLP spray paint guns that work with an air compressor. There are also various sizes of HVLP spray guns, small spray guns are used for applying graphics to vehicles or touch up jobs while the standard sizes are used for painting the entire vehicles. Using HVLP spray paint gun is economical and environment-friendly since it reduces overspray and that the toxic chemicals of the paint goes down, thus, protecting the painter and its surroundings. Moreover, the amount of paint that one used in painting a vehicle goes down, which could save a lot of money on paint costs. The also never comprises the quality of the finish. In fact, auto shop painters use HVLP spray paint guns when refinishing cars.

One brand in the market which dominates in the manufacturing of HVLP spray guns and that is SATA. SATA spray guns are high-performance spray guns which is environment and economically friendly. It saves 0.30% of major amount of paint material in comparison to conventional high pressure spray guns. The SATA spray guns featured a patented air circulation principle which gives the spray gun the homogenous and soft spray fan. This allows fast work since this is due to the wide spray fan and high material flow rate. On the other hand, it provides finest atomization and a perfect finish due to its high air volume. Thus, giving a significantly higher savings on paint material since it is only 3 to 5 cents per paint job for the additional costs of compressed air compared to regular high pressure spray gun. It also guarantees the high, well-known SATA quality because the nozzle sets are 100% adjustable by hand, on all complete SATA spray guns as well as replacement of nozzle sets. The nozzle is made of brass not that of aluminum which ensures a long life time of durability. Lastly, it makes sure transfer efficiency that is above 65% required by VOC legislation. So, if you want to have an affordable and quality HVLP spray gun, make sure it's SATA.